

REMARKS

In response to the Office Action mailed November 12, 2008, Applicant respectfully requests reconsideration. To further the prosecution of this application, each of the rejections set forth in the Office Action has been carefully considered and is addressed below. The application as presented is believed to be in condition for allowance.

Initially, Applicant thanks Examiner Blackwell and his supervisor, Examiner Doug Hutton, for the courtesies extended during the telephone interview of January 29, 2009 with Applicant's representative, Scott J. Gerwin. The substance of this interview is summarized herein.

Status of Claims

The Office Action rejects claims 1, 14, and 16 under 35 U.S.C. §102(b) as purportedly being unpatentable over Olbricht (6,429,952), and rejects claim 15 under 35 U.S.C. §103(a) as purportedly being obvious over Olbricht in view of Abrams (2004/0205459). In addition, the Office Action rejects claims 49, 50, 52, 54-57, 68, 70-72, 74, 76-79, 90, 92-94, 96-101, 112, and 114 under 35 U.S.C. §103(a) as purportedly being obvious over Olbricht in view of Green (2004/0205459), and rejects claims 51, 53, 58-62, 63-67, 69, 73, 75, 80-84, 85-89, 95, 97, 102-111, and 113 under 35 U.S.C. §103(a) as purportedly being obvious Olbricht in view of Green in combination with various other references. Claim 115 is rejected under 35 U.S.C. §103(a) as purportedly being obvious over Olbricht in view of Gann (6,965,460).

Claim 1

Claim 1 recites, *inter alia*, an act of, "in response to selection of the button, retrieving previously-stored data that represents at least one picture and that has been previously associated with the electronic document." Olbricht fails to disclose or suggest any such limitation.

During the interview, Applicant's representative asked Examiner Blackwell and Examiner Hutton to explain how they believed Olbricht discloses retrieving an image previously-associated with a document in response to selection of a button.

The Examiners explained that they understood Olbricht to disclose that when the “Preview” button shown in Figure 2 is selected, an image is generated and associated with the screen shown in Figure 2. The Examiners stated that, if the “Scan” button is subsequently selected, that causes the previously-associated image to be retrieved and displayed.

Applicant’s representative pointed out that the image that is retrieved when the “Scan” button is selected is a different image than the image that is generated when the “Preview” button is selected, and that selecting the “Scan” button causes a new image to be generated, not an image that has been previously-associated with the screen in Figure 2.

The Examiners acknowledged that, in Olbricht, when the “Scan” button is selected, a new image is generated, but pointed out that if the same item that is in the scanner when the “Preview” button is selected is still in the scanner when the “Scan” button is selected, the image that is generated when the “Scan” button is selected will be an image of the same item that was scanned in response to the “Preview” button having been selected. The Examiners questioned whether these two images could be considered to be the same image because they were images of the same item.

Applicant’s representative disagreed that these two images could be considered to be the same image, but proposed amending claim 1 to clarify that the at least one image is represented by particular data, and it is the particular data that represents the at least one image that is retrieved in response to selection of the button.

The Examiners acknowledged that in Olbricht, when the “Scan” button is selected, data is created that is different from the data that is created when the “Preview” button is selected, and the data that is created when the “Preview” button is selected is not retrieved when the “Scan” button is selected. While understandably reserving final judgment until reviewing the amended claim, the Examiners indicated that if claim 1 were amended to clarify that the at least one image is represented by data, and that it is that data that is retrieved when the button is selected, they believed claim 1 would patentably distinguish over Olbricht.

Claim 1 has been so amended and now recites, “in response to selection of the button, retrieving previously-stored data that represents at least one picture and that has been previously associated with the electronic document.”

As Olbricht does not disclose retrieving, in response to selection of a button, previously-stored data that has previously been associated with an electronic document, claim 1 patentably distinguishes over Olbricht, and it is respectfully requested that the rejection of claim 1 be withdrawn.

Claims 14-16 depend from claim 1 and are patentable for at least the same reasons. Accordingly, it is respectfully requested that the rejection of these claims be withdrawn.

Claims 49, 71, and 93

Each of independent claims 49 and 71 as amended, includes limitations relating to acts of, in response to selection of the first button, calling an image capture application to capture at least one image and to create data that represents the at least one image, and associating the data that represents the at least one image captured by the image capture application with the first location in the first electronic document so that the data that represents the at least one image is retrievable in response to selection of a second button at the first location in the first electronic document. Claim 93 includes a limitation directed to at least one controller that performs these acts.

The Office Action concedes that Olbricht does not disclose making data associated with a first location in a first electronic document retrievable in response to selection of a second button at the first location, but asserts that Green discloses this limitation. In particular, the Office Action appears to assert that Green discloses a screen on which thumbnails of previously-scanned images are displayed, and wherein selecting one of the thumbnails causes a larger version of the image to be displayed.

During the telephone interview, Applicant's representative asked the Examiners to explain what they believed the system resulting from the combination of Olbricht and Green would look like.

The Examiners explained that they believe one of skill in the art would have modified the screen shown in Figure 2 of Olbricht, so that the screen would also display thumbnails of previously-scanned images (as taught by Green), and would, when one of the thumbnails is selected, display the previously-scanned image on the left-hand side of the screen.

Applicant's representative pointed out that Figure 2 of Olbricht shows a screen that is used to initiate the generation of images of items that are placed in the scanner. Applicant's representative further explained that, in Green, Figure 6 shows the screen that is used to initiate the generation of images of items in a scanner, and that Green discloses displaying the thumbnails in a an entirely different screen from the screen shown in Figure 6. Applicant's representative asked the Examiners why they believe one of skill in the art would have modified Olbricht to display the thumbnails on the same screen that is used to initiate generation of images of items in the scanner, when Green teaches displaying these thumbnails on a separate screen.

The Examiners explained that they believe one of skill in the art would have recognized that these thumbnails could either be displayed on the same screen used to initiate scanning of an item in the scanner or on a different screen, and that it would be a matter of design choice to select one of these options.

Applicant respectfully disagrees with this reasoning. The modification that the Examiners assert that one of skill in the art would have made to Olbricht based on the teachings of Green does not follow the teachings of Green. That is, Green teaches displaying the thumbnails on a different screen from the screen used to initiate scanning of an image. The Examiners contend that one of skill in the art would have contradicted the teachings of Green, and modified Olbricht so that these thumbnails are displayed on the same screen that is used to initiate scanning.

The Examiners do not provide any rationale as to why one of skill in the art would have gone against the teachings of Green and modified Olbricht in a different way that is not taught or suggested by any of the cited prior art.

As such, the Office Action has failed to establish a *prima facie* case of obviousness for claims 49, 71, and 93, and it is respectfully requested that the rejections of these claims be withdrawn.

Claims 50-70 depend from claim 49, claims 72-92 depend from claim 71, and claims 94-114 depend from claim 93. Each of these dependent claims is patentable for at least the same reasons as the independent claim from which it depends. Accordingly, it is respectfully requested that the rejection of these claims be withdrawn.

Claim 115

By this amendment, Applicant cancels claim 115. Thus, the rejection of claim 115 under 35 U.S.C. §103(a) is moot. Applicant reserves the right to pursue the subject matter of claim 115 in a continuing application.

CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Dated: February 12, 2009

Respectfully submitted,

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